

Appl. No. 09/717,939
Amdt. Dated November 14, 2003
Reply to Final Office Action of July 14, 2003

REMARKS

Favorable reconsideration and allowance of the present application are respectfully requested in view of the foregoing amendments and the following remarks.

Claims 2-10, 13-26, 28-38, and 41-54 are currently pending in the present application, including independent claims 18, 45, and 46. Claims 5, 20, 33, and 45-46 have been amended in this paper, while claims 12 and 40 have been cancelled in this paper. Additionally, new claims 53-54 have been added.

Applicants thank Examiner Joynes for the telephone interviews conducted with Attorney for Applicants regarding this application on October 14 and 28, 2003 and November 3, 10, and 13, 2003. During the November 10 and 13, 2003 interviews, it was specifically discussed that the Examiner is withdrawing the claim rejections under 35 U.S.C. § 112, second paragraph, regarding the language "oil-in-water emulsified" used to describe the lotion recited in the claims.

In the Office Action, independent claim 45 was rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,869,075 to Krzysik, et al., alone or in combination with U.S. Patent No. 4,559,157 to Smith, et al. As discussed during the November 13, 2003 telephone interview with the Examiner, claim 45 has been amended herein to recite that the oil-in-water emulsified lotion "consists essentially of" water, the emollient component, the fatty alcohol component, the emulsifier component, and the skin conditioning component, in the particular concentrations recited in claim 45. Although other ingredients may be contained in the oil-in-water emulsified lotion composition of claim 45 (e.g., antimicrobial agents, preservatives, colorants, fragrances, etc.) (Appl. at pages 12-14), the high molecular weight polyethylene glycol, having a molecular weight of about 720 or greater, of Krzysik, et al. is excluded from the lotion of claim 45.

The use of such a high molecular weight polyethylene glycol renders the hydrophilic composition of Krzysik, et al. a solid at room temperature, which has a melting point from about 30°C to about 70°C and a penetration hardness of less than about 360 mm. (See, e.g., col. 2, lines 1-11 and cols 5-8). In every embodiment of Krzysik, et al., such a polyethylene glycol having a molecular weight of about 720 or

Appl. No. 09/717,939

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great r is present in th hydrophilic composition in an amount of from about 10 to about 50 weight p rcent. (Col. 1, lines 59-63). In contrast, the oil-in-water emulsified lotion recited in claim 45 is a soft, semi-solid or a viscous liquid at room temperature. Yet, Krzysik, et al. clearly teaches away from the use of such a soft, semi-solid lotion composition, for instance, in Examples 1 and 2 (Krzysik, et al.'s two examples outside its claimed invention) where the reference describes that tissue softening formulations (soft, semi-solid jellies) having a penetration hardness *greater than* 360 mm were prepared and applied to a towel basesheet but were "too soft to sit on the surface of the basesheet." (Col. 5, line 64 – col. 6, line 45). Instead of such soft, semi-solid jellies, Krzysik, et al. provides for a hydrophilic composition that is *solid* at room temperature and must be melted in order to be applied to tissues and towel products, only to later be resolidified into large numbers of individual *solid* deposits of hydrophilic composition on such tissues and towel products. Thus, Applicants respectfully submit that claim 45 patentably defines over Krzysik, et al. for at least the reasons stated above.

In the Final Office Action, Krzysik, et al. was also combined with Smith, et al. to reject claim 45. As discussed during the telephone interview with Examiner Joynes, Applicants respectfully submit that it would not have been obvious to combine the disclosure of Smith, et al. with the disclosure of Krzysik, et al. and arrive at the paper product of claim 45. Smith, et al. is directed to cosmetic applicators comprising absorbent sheets impregnated with an oil-in-water emulsion, which incorporates various emollients adapted for moisturizing wet skin surfaces. (Abstract, col. 1, lines 41-58). These cosmetic applicators are formed such that the emulsion comprises about 300-1000% based on the weight of the porous sheet to which it is applied (i.e., 8-10 grams, and up to 15-17 grams of emulsion may be applied to one 1.7-2.5 gram sheet of fabric). (Col. 4, line 58 – col. 5, line 9). Such high add-on levels render the cosmetic applicators of Smith, et al. capable of supplying one or more "whole-body moisturizations." (Col. 1, lines 33-35; col. 5, lines 1-9).

No motivation would have existed for one skilled in the art to combine the disclosures of Krzysik, et al. and Smith, et al., since Krzysik, et al. seeks a "lower add-on amount" of composition (col. 1, lines 55-58), focusing on the formation of large

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numbers of individual *solid* deposits of its hydrophilic composition on tissues and towel products, whereas no such resolidified composition is contemplated by the moist-to-the-touch, oil-in-water emulsion-impregnated cosmetic applicators of Smith, et al., which are formed at add-on levels of emulsion of 300-1000%. Further, even if some motivation to combine the disclosures of Krzysik, et al. and Smith, et al. existed, such a combination would not render obvious the absorbent paper product of claim 45 that includes an oil-in-water emulsified lotion at an add-on level of between about 1% and about 15%, where the lotion consists essentially of the components recited therein. Therefore, Applicants respectfully submit that independent claim 45 patentably defines over Krzysik, et al., alone or in conjunction with Smith, et al., for at least the reasons discussed above.

Independent claims 18 and 46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over a combination of Krzysik, et al., alone or in view of Smith, et al., with various additional references. Claim 46 has been amended in this paper to recite a method for forming a paper product wherein a web is applied with an oil-in-water emulsified lotion (at an add-on level of between about 1% to about 15% by weight of the paper product) "consisting essentially of" water, the emollient component, the fatty alcohol component, the emulsifier component, and the skin conditioning component, in the particular concentrations recited therein. Thus, for at least the reasons stated above with respect to claim 45, Applicants submit that the method of claim 46 patentably defines over the cited references.

With regard to independent claim 18, Applicants respectfully submit that the combination of references described at pages 8-9 of the Final Office Action does not render obvious the absorbent paper towel recited therein. Looking first to Krzysik, et al., it should be noted that Krzysik, et al. fails to disclose the components of the oil-in-water emulsified lotion and the weight ranges of those components recited by independent claim 18. For example, independent claim 18 requires an oil-in-water emulsified lotion having the following:

- i) water in an amount between *about 10% to about 75%*;

Appl. No. 09/717,939

Amdt. Dated November 14, 2003

Reply to Final Office Action of July 14, 2003

- ii) an emollient component in an amount between *about 1% to about 15%*, where the emollient component includes C₁₂-C₁₅ alkyl benzoate;
- iii) a fatty alcohol component in an amount between *about 5% to about 40%*, including one or more of the following fatty alcohols: cetyl alcohol, stearyl alcohol, cetearyl alcohol, arachidyl alcohol, and behenyl alcohol;
- iv) an emulsifier component in an amount between *about 1% to about 30%*; and
- v) a skin conditioning component comprising between *about 5% to about 50%*, the skin conditioning component including glycerin in an amount between *about 1% to about 10%*.

Among other things, Krzysik, et al. does not disclose or suggest using glycerin in an amount between about 1% to about 10%, nor does it disclose or suggest an emollient component that includes C₁₂-C₁₅ alkyl benzoate. Krzysik, et al. also does not disclose or suggest the claimed percentages in which an emollient component and an emulsifier component are used in a lotion. Thus, again, Applicants respectfully submit that independent claim 18 patentably defines over Krzysik, et al.

The above-described deficiencies in the disclosure of Krzysik, et al. compared to claim 18 are not cured by the disclosure of Smith, et al. for at least the reasons argued above with regard to claims 45 and 46. Looking to the additional references cited against claims 18 and 46 in the Office Action, U.S. Patent No. 5,948,416 to Wagner, et al. was described as teaching a humectant such as glycerin. However, Wagner, et al. is directed to leave-on skin care compositions that are not applied to paper products. To the contrary, Krzysik, et al. describes a composition that is particularly designed to be applied to a paper-based product (i.e., a tissue product). In fact, the composition of Krzysik, et al. is resolidified on the surface of the tissue product to inhibit migration of the components into the interior of the product. Skin care compositions, such as described in Wagner, et al., are clearly not faced with the difficulties of lotion migration, and one of ordinary skill in the art would thus not have been motivated to combine such references in the manner suggested in the Office Action.

Nevertheless, even if Wagner, et al. and Krzysik, et al. are combined in the manner suggested in the Office Action, Applicants still submit that the limitations of independent claims 18 and 46 as a whole would not have been obvious to one of

Appl. No. 09/717,939
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ordinary skill in the art. Specifically, even if the composition taught in Krzysik, et al. were modified with the teachings of Wagner, et al., one of ordinary skill in the art, when viewing the references in their entirety, would not have found it obvious to utilize the combination of all the claimed ingredients in the oil-in-water emulsified lotion, in their particular claimed concentration ranges, on a paper product or a paper towel at the claimed add-on level.

Besides Wagner, et al., various other references were also combined with Krzysik, et al. in an attempt to achieve the limitations of the present claims. For instance, U.S. Patent No. 5,871,763 to Luu, et al. was cited as teaching the use of certain specific emollients. U.S. Patent No. 5,648,083 to Blieszner, et al. was cited as teaching the use of dimethicone as a skin-conditioning agent. Finally, U.S. Patent No. 5,716,692 to Warner, et al. was cited as teaching different types of paper and methods of treating paper. Nevertheless, even assuming that these references disclose such limitations, they fail to cure the defects discussed above. Accordingly, for at least the reasons set forth in this paper, Applicants respectfully submit that independent claims 18, 45, and 46 patentably define over the above-cited references, taken singularly or in any proper combination.

In addition, the above-cited references were cited in various combinations to reject dependent claims 2-10, 12-17, 19-26, 28-38, 40-44, and 47-52. Applicants respectfully submit, however, that at least for the reasons indicated above relating to corresponding independent claims 18, 45, and 46, claims 2-10, 13-17, 19-26, 28-38, 41-44, and 47-52 patentably define over the references cited. However, Applicants also note that the patentability of dependent claims 2-10, 13-17, 19-26, 28-38, 41-44, and 47-52 does not necessarily hinge on the patentability of independent claims 18, 45, and 46. In particular, some or all of claims 2-10, 13-17, 19-26, 28-38, 41-44, and 47-52 may possess features that are independently patentable, regardless of the patentability of claims 18, 45, and 46.

As such, for at least the reasons set forth above, Applicants respectfully submit that the present claims patentably define over all of the prior art of record. It is believed that the present application is in complete condition for allowance and favorable action,

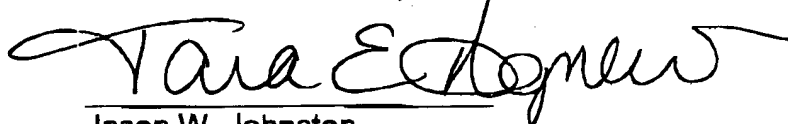
Appl. No. 09/717,939
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Reply to Final Office Action of July 14, 2003

ther fore, is respectfully requested. Examiner Joynes is invited and encouraged to telephone the undersigned, however, should any issues remain after consideration of this response.

Please charge any additional fees required by this Amendment to Deposit Account No. 04-1403.

Respectfully submitted,

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